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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,432	06/25/2003	Scott T. Peterson	873-01-PA-J	4311
7590 06/10/2004 KLEIN, O'NEILL & SINGH 2 Park Plaza, Suite 510 Irvine, CA 92614			EXAMINER FRANCIS, FAYE	
			ART UNIT 3712	PAPER NUMBER
DATE MAILED: 06/10/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/603,432

Applicant(s)

PETERSON ET AL.

Examiner

Faye Francis

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18 and 20 is/are rejected.
- 7) ☒ Claim(s) 17 and 19 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/25/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the apertures formed in the larger inner end in claim 4 and uneven inner end in claim 15 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The specification is objected to because on page 4 lines 2 and 8, reference characters "22" and "24" have both been used to designate inner end.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 1, 3, 6, 8, 10, 12-16, 17 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1: the phrase "the head having an opening formed therein to create an adjustable ring" is inaccurate since having a head with an opening formed therein does not create an adjustable ring.

Claims 1 and 15 are indefinite since all that the applicant considers to be encompassed by the phrase "squid-like toy" cannot be determined.

With respect to claim 3: the phrase "larger inner end" is confusing. The inner end is large than what?

With respect to claims 6, 13 and 16: the scope of the claim is unclear because of the improper use of Markush therein.

Claim 12 is indefinite because it is not clear what the phrase "a ballistic-shape" is intended to encompass.

Claims 6 and 13 are indefinite since all that the applicant considers to be encompassed by the phrase "an equivalent plastic" cannot be determined. What plastic is equivalent to silicone or rubber?

With respect to claims 8, 10, 14, 18 and 20: the phrase "the elongated members are substantially circular and oval in shape" is confusing. It is not clear how the elongated members are substantially circular and oval in shape at the same time.

In view of the examples above, the applicant is required to carefully review all of the claims in order to correct those having the same defects but not specifically pointed to.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-6 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Link et al, hereinafter Link.

Link discloses in Figs 1-6 and 11-12, a water sinker [lure 1] comprised of a plastic [col 3 lines 28-35] head [retainer 2, the molded body 5 and the ring attached to the top of the molded body] made from a material having sufficient weight to enable the water sinker to sink in water, a tail portion [strands 6] having a plurality of elements made from floatable material which inherently provide the water sinker with buoyancy. Additionally, Link discloses the head having an opening [the ring has an opening] which inherently can be adjusted. Also, Link discloses the head and the opening are approximately oval in shape with the head having a shaped outer end, away from the tail portion.

With respect to claim 4, Fig 3 shows apertures 28, 30 and 32.

7. Claims 1-7 and 11-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Link 6,598,336 hereinafter Link'336.

Link'336 discloses in Figs 1-17, a water sinker comprised of a plastic [col 4 lines 46-49] head [headpiece 28 and hook eye 38] made from a material having sufficient weight to enable the water sinker to sink in water, a tail portion [silicone rubber skirt 22] having a plurality of elements made from floatable material to provide the water sinker with buoyancy, the head having an opening [the area in the middle of the hook eye]

formed therein which is inherently adjustable [Fig I also shows an adjustable head opening [the ring attached to the top of the wire 5]]. Additionally, Link'336 discloses the head and the opening are approximately oval in shape with the head having a shaped outer end, away from the tail portion.

With respect to claim 4, Fig 6 shows apertures 76.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Link'336.

Link'336 discloses most of the elements of this claim as stated above.

Link'336 does not disclose that there are between 12- to 52 elongated members.

On the other hand, it would have been obvious to one having ordinary skill in the art at the time invention was made to modify the device as disclosed by Link'336 to have any number of elongated members as claimed in order to present a more enticing presentation to a particular fish species being sought.

10. Claims 7, 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Link.

Link discloses most of the elements of these claims as stated above.

Link does not disclose that there are between 6 to 52 or 12 to 52 elongated members. On the other hand, it would have been obvious to one having ordinary skill in

the art at the time invention was made to modify the device as disclosed by Link to have any number of elongated members as claimed in order to present a more enticing presentation to a particular fish species being sought.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Allowable Subject Matter

12. Claims 17 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claim 15 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

14. Claims 8, 10, 14, 16, 18 and 20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

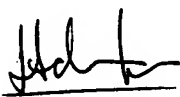
Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FF


Jacob K. Ackun
Primary Examiner